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In re Application of :
MCDONALD, Andrew et al. :
Application No.: 10/527,540 : DECISION ON
PCT No.: PCT/US2003/028696 :
Int. Filing Date: 11 September 2003 : PETITION
Priority Date: 13 September 2002 :
Attorney Docket No.: 209367.0044-00000 : UNDER 37 CFR 1.47(a)
For: COMPOUNDS, COMPOSITIONS AND :
METHODS :
:

This is a decision on applicants' Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 03 January 2007.

BACKGROUND

On 11 September 2003, applicants filed international application PCT/US2003/028696, which claimed a priority date of 13 September 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 March 2005.

On 11 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 02 August 2006, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors and the surcharge for late filing of the search fee, examination fee or oath or declaration were required.

On 03 January 2007, applicants submitted a petition under 37 CFR 1.47(a) and the fee for a two month extension of time.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1) and (3) have been satisfied. The balance of the \$200 petition fee will be charged to deposit account no. 06-0916, as authorized. Applicants list Andrew McDonald's address as 9 Barrow Street, Apt. D, New York, NY 10014-3864.

Item (2) has not been satisfied. Applicants have sent a complete copy of the application papers to two different residences for Mr. McDonald and to a work address. However, applicants have not provided evidence that any of the packages were received. The packages were not signed for by Mr. McDonald. The email did not receive a response. The delivery receipt of the email is not evidence of receipt by Mr. McDonald. Further, a week later, applicant is sending a package to a residence across the country from that employment. Applicants had a phone number for Mr. McDonald and apparently did not attempt to contact him to confirm receipt of the packages.

Item (4) has not been satisfied. An oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required to list the inventors and their citizenships. The international publication indicates that Han-Jie Zhou is a citizen of China and a resident of the United States and that Andrew McDonald is a citizen and resident of the United States. The declaration signed by Mr. Zhou indicates that he is a citizen of the United States and that Mr. McDonald is a citizen of China. While it is possible that Mr. Zhou has become a United States citizen, it seems unlikely that Mr. McDonald has also become a citizen of China. If Mr. Zhou has not become a citizen of the United States, then an explanation as to why he signed a declaration indicating that he was one is in order. If the citizenships are not correct on the declaration, a new oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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